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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
MISIASZEK, MICHAEL	
ART UNIT	**PAPER NUMBER**
3625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/733,830	HEINS, DOUGLAS B.	
	Examiner	Art Unit	
	Michael Misiaszek	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27 and 29-73* is/are pending in the application.

4a) Of the above claim(s) *29-73* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's amendments filed 1/12/2007 have been received and reviewed. The status of the claims is as follows:

Claims 1-27 and 29-73 are pending. Claim 28 has been cancelled by the applicant. Claims 29-73 have been withdrawn from consideration by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1, 2, 4, 5, 10, 13, 17, and 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berarducci in view of Reed et al. (US 20050004978 A1, hereinafter Reed).

Regarding Claim 1

Berarducci discloses a computer implemented method for performing the business of placing a digital image processing and fulfillment order via a communications network comprising:

- identifying a user (at least paragraph [0025]: user account)

- acquiring an at least one digital image captured by a digital imaging device (at least abstract)
- associating profile, personalization and customization aspects to said identified user into a user provisioner (at least paragraph [0040]: user service account options)
- said profile aspects include a user address, a user contact information, and a user billing information (at least figure 5A)
- said personalization aspects include a choice of digital photography enhancement (at least paragraph [0043]: addition of time stamp), a choice of automated rendering (at least paragraph [0044]: selection of size), a choice of digital photography layout (at least figures 3-4: matte, background, etc.), a choice of digital photography fulfillment presentation (at least paragraph [0041]: standard prints, album, etc..)
- said customization aspects include a physical hardcopy fulfillment (at least paragraph [0016]: image printing), a choice of vendor for hardcopy fulfillment (at least paragraph [0062]: retail kiosk chosen), and a choice of hardcopy fulfillment or other non-physical means of taking delivery (at least paragraph [0062]: prints delivered to kiosk or directly to customer)
- automatically performing a single-event instantiation process which completes a user request, said single-event instantiation process including sending a processing and fulfillment order along with the user provisioner to a plurality of system components, the plurality of system components operating to fulfill said

user request (at least paragraph [0033]: user places an order, which uses service account)

- receiving said user request under control of a single-event instantiation of a plurality of processing and fulfillment system components (at least paragraph [0033]: user places order)
- retrieving the provisioner associated with said identified user (at least paragraph [0033]: user places an order, which uses service account)
- determining payment and authorization methods using said user provisioner
- retrieving a fulfillment delivery method using said user provisioner (at least paragraph [0039]: delivery information)
- providing for user personalization and customization of the order processing and fulfillment workflow using said user provisioner (at least paragraph [0041]: preferred fulfillment times)
- fulfilling said processing and fulfillment order to complete processing and fulfillment of the single-event instance (at least paragraph [0041]: order fulfilled)
- whereby the processing and fulfillment order is completed without using a software application, a web online service, or a traditional shopping cart ordering model (at least paragraph [0037]: order fulfilled through ground mail)

Berarducci does not explicitly disclose:

- a preferred means of notification

Reed teaches that it is known to include a preferred means of notification (at least paragraph [0136]: user's preference for notification) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method, as taught by Berarducci, with the notification preference, as taught by Reed, since such a modification would have provided increased control for a consumer in a transaction system through personalized preferences (at least paragraph [0210] of Reed).

Regarding Claims 2, 4, 5, 10, 13, 17, 20-26

Berarducci discloses:

- wherein the step of automatically performing a single-event instantiation process is the result identification of the user and acquisition said at least one digital image (at least paragraph [0038] and abstract: login and picture acquisition)
- wherein user identification involves entry of user id and password in a single-event instantiation (at least paragraph [0007]: password and user id login)
- wherein user identification involves an email address and password in a single-event instantiation (at least paragraph [0007]: password and email address login)

- wherein the acquisition of digital images is made via a direct cable link to the digital imaging device (at least paragraph [0029]: cable connection)
- wherein the digital imaging device is a digital still camera device (at least paragraph [0029]: Kodak digital camera)
- wherein the user is a single user and the information regarding the user is captured dynamically and additional information augments the dynamic user information during the single-event instantiation of a processing and fulfillment order (at least paragraph [0040]: user account information augmented)
- wherein the client system and the plurality of system components communicate via a Wide Area Network such as the Internet (at least paragraph [0016])
- wherein the client system and the plurality of system components communicate via a secure connection utilizing encryption for those portions of the processing and fulfillment order for which security and privacy are desired (at least paragraph [0040])
- wherein the client system connects to a plurality of system components comprising:
    - a) under control of an individual system component, the means to receive a processing and fulfillment order from either a client system or from another system component (at least paragraph [0041]: fulfillment center receives order)
    - b) and, within each system component contain the necessary computing resources to locate additional information needed to execute their

individual affects on the processing and fulfillment order (at least paragraph [0033]: database obtains billing information)

- c) and, within each system component contain the necessary computing resources to access and augment the user provisioner needed to execute their individual affects on the processing and fulfillment order and update the provisioner as necessary to reflect the system component is complete (at least paragraph [0040]: information augmented)

- wherein the system components can serve multiple purposes in completing one or more aspects of the processing and fulfillment order (at least paragraphs [0033] and [0041]: database and fulfillment center)
- wherein the system components can process multiple single-event instantiations of the user request processing and fulfillment order, each mutually independent from each other (at least paragraph [0063]: system can handle multiple orders from one user)
- wherein one system component is a server offering one or more different processing and fulfillment behaviors (at least paragraph [0016]: system is on Internet, therefore having a server that can complete separate tasks)
- wherein one system component is user email account displaying an email information message pertinent to the user request processing and fulfillment order status (at least paragraph [0058]: email to user account)

2. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berarducci and Reed, as applied to claim 1 above and further in view of Mauro.

Berarducci and Reed teaches the claimed invention except for:

- the user does not need to explicitly, directly or indirectly, specify operations, manipulations or enhancements on the at least one digital image, either singularly or as a group or collection, when placing a processing and fulfillment order
- the acquisition of digital photographs uses a digital media memory card reader.

Mauro teaches that it is know to include providing for a user to not have to explicitly specify operations on digital images (at least paragraph [0018]: default photofinishing options for user) and acquiring digital photographs using a digital media memory car reader (at least abstract) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method, as taught by Berarducci and Reed, with the default options and memory card reader of Mauro, since such a modification would have provided a means of minimizing necessary customer interaction with a photofinishing service (at least paragraph [0004] of Mauro).

3. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berarducci and Reed, as applied to claim 1 above and further in view of Ramachandran.

Berarducci and Reed teaches the claimed invention except for:

- user identification is a credit card/ATM swipe in a single-event instantiation
- user identification in a single-event instantiation is enabled through a smart chip enabled device
- user identification in a single-event instantiation is enabled through a biometric identification

Ramachandran teaches that it is known to include user identification by a credit card swipe, a smart chip enabled device, and biometric identification (at least paragraph [0048]: obtaining of user's account information) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method taught by Berarducci and Reed with the user identification techniques, as taught by Ramachandran, since such a modification would have provided a means of associating a fee for the distribution of digital content (at least paragraph [0018] of Ramachandran).

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berarducci and Reed, as applied to claim 1 above and further in view of House.

Berarducci and Reed teaches the claimed invention except for:

- the single-event instantiation of user identification is a self mailer/drop-off mailer model

House teaches that it is known to include using a self mailer/drop-off mailer model (at least paragraph [0073]) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method, as taught by Berarducci and Reed, with the self mailer model, as taught by House, since such a modification would have provided a means for offering the best delivery options based on user input (at least paragraph [0073] of House).

5. Claims 11, 14, 15, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berarducci and Reed, as applied to claim 1 above and further in view of Paul.

Berarducci and Reed teaches the claimed invention except for:

- the acquisition of digital images is made via a wireless link to the digital imaging device
- the digital imaging device is a digital video camera device
- the digital imaging device is a mobile radiotelephone device
- one system component is a user text messaging account destination displaying information pertinent to the user request processing and fulfillment order

Paul teaches that it is known to include acquiring digital images via a wireless link (at least abstract), the digital image device being a digital video camera device (at least paragraph [0019] or a mobile radiotelephone device (at least paragraph [0032]: camera phone), and a user text messaging account destination displaying information pertinent to the order (at least paragraph [0036]: SMS) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method, as taught by Berarducci and Reed, with the wireless link, digital imaging devices, and text messaging, as taught by Paul, since such a modification would have provided a means for users to have limitless developed pictures without running out of film (at least paragraph [0025] of Paul).

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berarducci and Reed, as applied to claim 1 above and further in view of Chauvin.

Berarducci and Reed teaches the claimed invention except for:

- the digital imaging device is a portable digital assistant computing device with digital camera extension.

Chauvin teaches that it is known to include a portable digital assistant with a digital camera extension as a digital imaging device (at least paragraph [0051]) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method as taught by Berarducci and Reed, with the personal digital assistant with digital camera extension, as taught by Chauvin, since such a modification would have provided a means for various types of entities to be used for imaging services (at least paragraph [0008] of Chauvin).

7. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berarducci and Reed, as applied to claim 1 above and further in view of von Rosen.

Berarducci and Reed teaches the claimed invention except for:

- the entire single-event instantiation of a processing and fulfillment order offers a preview of the entire processing and fulfillment workflow to verify and validate that all options are valid and available as specified by the user provisioner
- the presentation of information captured during a preview of the entire processing and fulfillment workflow permits the user to fine-tune choices and options prior to final commitment

Rosen teaches that it is known to include a preview of the workflow options of an order, in which the options can be fine-tuned (at least figure 11B: user can go back to change options if desired) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method, as taught by Berarducci and Reed, with the workflow preview, as taught by Rosen, since such a modification would have provided a means to allow consumers to easily and conveniently purchase merchandise personalized to their own tastes (at least paragraph [0004] of Rosen).

Response to Arguments

Applicant's arguments with respect to claim 1 have been fully considered but they are not persuasive. Applicant asserts that Berarducci does not disclose various elements of the claimed user provisioner, and that nothing in Berarducci corresponds to the user provisioner. As detailed in the rejection above, Berarducci discloses service account information, which corresponds to the provisioner and includes a majority of the elements, and Reed teaches the remaining element.

Applicant further asserts that Berarducci does not disclose that service account options are not included automatically, and that Berarducci further teaches away from this feature. However, since the service account options are included through a computer system, the inclusion process must be performed automatically at some level. Any process performed by a computer is, by definition, and automatic process. Accordingly, Berarducci discloses the automation and does not teach away from this feature.

Applicant still further asserts that providing preferred upload times does not fall under user customization and personalization aspects of the user provisioner. However, providing these preferences is, indeed a form of user customization and personalization using the user provisioner, as claimed.

Applicant's arguments with respect to claim 9 have been fully considered but they are not persuasive. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Further, in response to applicant's argument that House is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, House is in applicant's general field of endeavor, which is the purchasing of media (see at least the abstract of House).

Applicant's arguments with respect to claim 16 have been fully considered but they are not persuasive. Applicant asserts that the digital imaging devices in Chauvin are used to place orders, and not acquire digital images. However, the *imaging devices* are used to acquire digital images and may also be used to order the images (see at least paragraph [0061]: images acquired using digital camera ordered). Further, applicant asserts that Chauvin does not disclose a PDA with a digital camera extension. The Examiner submits that it is old and well known in the art that PDAs commonly have digital camera extensions and further submits that it would be obvious for a PDA used as an "imaging device" to have such an extension.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Misiaszek whose telephone number is (571) 272-6961. The examiner can normally be reached on 8:00 AM - 4:30 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael A. Misiaszek
Patent Examiner
3/28/2007

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